



UNITED STATES DEPARTMENT OF COMMERCE
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JOHNSTON, ERIC RYAN,
MOTOREOLA, INC.
INTELLECTUAL PROPERTY DEPARTMENT
600 NORTH U.S. HWY 45
LIBERTYVILLE, IL 60040

12/27/96

EXAMINER
ROBERT L. BROWN

ART UNIT	PAPER NUMBER
17	12/27/96

DATE MAILED: 12/27/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined Responsive to communication filed on 12/27/96 This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892.
2. Notice of Draftsman's Patent Drawing Review, PTO-948.
3. Notice of Art Cited by Applicant, PTO-1449.
4. Notice of Informal Patent Application, PTO-152.
5. Information on How to Effect Drawing Changes, PTO-1474.
6.

Part II SUMMARY OF ACTION

1. Claims 19-24, 26-31, 33-38 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. Claims 1-18, 25, 32, 39 have been cancelled.

3. Claims _____ are allowed.

4. Claims 19-24, 26-31, 33-38 are rejected.

5. Claims _____ are objected to.

6. Claims _____ are subject to restriction or election requirement.

7. This application has been filed with informal drawings under 37 C.F.R. 1.35 which are acceptable for examination purposes.

8. Formal drawings are required in response to this Office action.

9. The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are acceptable; not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been approved by the examiner; disapproved by the examiner (see explanation).

11. The proposed drawing correction, filed _____, has been approved; disapproved (see explanation).

12. Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has been received not been received been filed in parent application, serial no. _____; filed on _____.

13. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. Other _____

EXAMINER'S ACTION

EXAMINER'S RESPONSE

Status of Application.

1. In response to the applicant's amendment received on 12/27/96. The examiner has considered the new presentation of claims and applicant arguments in view of the 5 disclosure and the present state of the prior art. And it is the examiner's position that claims 19-24,26-31,33-38 are unpatentable for the reasons set forth in this office action:

CLAIMS

10 2. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

15 The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as the specification, as originally filed, does not provide support for the invention as now claimed.

20 Specifically, the claimed definition of a cycle as comprising "a first period when the alert is generated followed by a second period when the alert is not generated," is not support by the specification as originally filed.

3. Claims 19-22,24-27,29-32,34-37 rejected under 35 U.S.C. § 112, first

paragraph, for the reasons set forth in the objection to the specification.

DOUBLE PATENTING

4. Claims 19,24,29,34 are provisionally rejected under the judicially created
5 doctrine of non-obviousness-type double patenting as being unpatentable over claims
1,18,19,20 of U.S. application No. 220949 and claims 19,26,33 of U.S. application No.
220851.

The non-obviousness-type double patenting rejection is a judicially established
doctrine based upon public policy and is primarily intended to prevent prolongation of
10 the patent term by prohibiting claims in a second patent not patentably distinct from
claims in a first patent. *In re Schneller*, 397 f.2d 350,158 USPQ 210(CCPA 1968). A
timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would
overcome an actual or provisional rejection on this ground provided the conflicting
application or patent is shown to be commonly owned with this application. See 37
15 C.F.R. § 1.78(d).

A two part test is applied to the claims. 1) is the subject matter recited in the
claims of the application fully disclosed in the patent and covered by a claim in the
patent. If yes, the second test is 2) is there any reason why applicant was prevented
from presenting the same claims for examination in the issued patent (application) if
20 the answer is no a double patenting rejection is appropriate.

Here, the subject matter recited in the pending claim is fully disclosed in the

applications referred above and covers the same subject matter covered by claims 1,18,19,20 of U.S. application No. 220949 and claims 19,26,33 of U.S. application No. 220851. Further, there was no reason why applicant was prevented from presenting the same claim for examination in the other application. The applicant has not maintained a clear line of demarkation between the above applications. Furthermore, the applicant appears to intend the above applications referring to the same subject matter since all have the same title.

5. Claims 21-23,26-28,31-33,36-38 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,18,19,20 of U.S. application No. 220949 and claims 19,26,33 of application No. 220851 in view of Breeden and Ohyanagi as discussed above.

6. The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

REMARKS

Response to Arguments.

The following discussion is introduced in direct response to the arguments

presented in the instant amendment:

7. The applicant believes that the claimed invention differs from the prior art of record for the following reasons:

5 a. The applicant argues that there is support for the claimed invention.

8. Regarding the applicants arguments the examiner points out the following:

10 a. The sections of the specification pointed to by the applicant still do not support the invention as now claimed. The claims require the periodic generation of an alert for a predetermined number of cycles. This is supported by the specification. The claims then continue to require that each cycle includes a time when the alert is on and a time when the alert is off. This is not supported by the original specification.

Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a).

15 Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

20 A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY 25 EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED

FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

5

CONTACT INFORMATION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Zimmerman whose telephone number is (703) 305-4796.

10 Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4900.

15

20 703-305-4796

March 24, 1997

**Brian Zimmerman
Patent Examiner
Art Unit 2211**

